

## REMARKS/ARGUMENTS

Pending claims 1-30 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent Application Number 2002/0013784 (Swanson) in view of U.S. Patent Application Number 2004/0057131 (Hutzel). Applicant respectfully traverses the rejection.

With regard to claim 1, neither reference teaches or suggests a portable device that includes a control unit to combine a first audio signal and a generated second audio signal and provide the combined signal through a speaker of the portable device. In this regard, the primary reference Swanson merely teaches a cellular telephone. Nowhere however does Swanson teach or suggest a control unit of the cell phone that combines such first and second signals and provides the combined signal through a speaker of the cell phone.

Nor does the combination of Swanson with Hutzel teach or suggest such subject matter. Instead, Hutzel merely teaches that a rearview mirror housing may include a microphone. While Hutzel further discloses that audio processing techniques may be used to insure that vocal inputs to the microphone are distinguished from ambient noises, nowhere does Hutzel teach or suggest that a portable device include a control unit to combine multiple audio signals and provide a combined signal through a speaker of the portable device. Instead, Hutzel discloses that a digital system processor (DSP) that processes the input audio signals can be located in a rearview mirror or elsewhere in a vehicle cabin.

Nor is there any motivation to combine the audio transmission system of Swanson with the rearview mirror assembly of Hutzel. In this regard, Swanson discloses an audio data transmission system that includes cell phones as receivers of transmissions. Hutzel instead is directed to a rearview mirror assembly that has various utility functions, including the presence of a microphone.

In light of these disparate references, the Office Action appears to have engaged in the hindsight-based obviousness analysis that has been widely and soundly disfavored by the Federal Circuit. In order to prevent a hindsight-based obviousness analysis, the Federal Circuit requires that “to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant.” *In re Kotzab*, 55 U.S.P.Q.2d 1313, 1316-17 (Fed Cir. 2000).

With respect to claim 1, the Office Action contains no factual support for the motivation, suggestion, or teaching of the manner in which Swanson and Hutzel must be modified to render obvious claim 1. The conclusory statement that “it would have been obvious...to have incorporated a noise reduction means as taught by Hutzel et al. into the device of Swanson to have a higher quality sound” (Office Action, p. 2) does not adequately set forth a proper motivation to combine. *See In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2001).

Because the Office Action fails to adduce any factual findings that would support a motivation for, or suggestion of, the alchemy by which Swanson and Hutzel might be modified to yield the subject matter of claim 1, a *prima facie* case of obviousness has not been made.

For at least these reasons, claim 1 and claims 2-7 are patentable over the proposed combination.

With regard to claim 8, the cited references, either alone or in combination, nowhere teach or suggest receiving a first audio signal from a storage unit of a portable device, generating a second audio signal to reduce undesirable sound, and combining these first and second audio signals in the portable device. In this regard, Swanson merely teaches that audio data may be played by a cellular phone or similar device. Hutzel teaches that a microphone input can be processed to enhance vocal signal to background noise discrimination ratio. However, nowhere does Hutzel or Swanson teach or suggest that such a processed signal may be combined with a stored audio signal. Certainly, neither reference teaches or suggests combining such audio signals in a portable device. Nor, as discussed above, is there any motivation to combine these references. Accordingly, claims 8-12 are patentable.

For similar reasons, claim 13 is patentable over the proposed combination. That is, the combination nowhere teaches or suggests combining a first audio signal received from a storage with an audio signal generated to reduce an undesirable audio signal. Accordingly, in addition to the lack of motivation to combine the references discussed above, for these further reasons claim 13 and claims 14-18 are patentable over the proposed combination.

As to independent claim 19, neither of the references teaches or suggests a wireless phone that includes a control unit to combine first and second audio signals, one of which is generated in the control unit, and provide the combined signal to a speaker of the wireless phone. Nor, as discussed above, is there any motivation to combine these references. Thus claims 19-25 are patentable.

In addition to the lack of motivation to combine the references, claim 26 is further patentable. That is, neither reference, alone or in combination, teaches or suggests a signal adder to combine a second audio signal with an audio reduction signal generated in a communications device based on at least a portion of a sensed signal, and a control unit that provides the combined signal to an output interface. Accordingly, claims 26-30 are patentable over the proposed combination.

In view of these remarks, the application is now in condition for allowance and the Examiner's prompt action in accordance therewith is respectfully requested. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 20-1504 (ITL.0597US).

Respectfully submitted,

  
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